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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,727	12/04/2003	Rainer Hoefer	C 2321 COGG	7177
23657	7590	05/31/2007		
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			EXAMINER GRAY, JILL M	
			ART UNIT 1774	PAPER NUMBER
			MAIL DATE 05/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/727,727

Applicant(s)

HOEFER

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-6 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-6 and 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Prior art reference Hoefer et al, 7,094,816 has been withdrawn in view of applicant's arguments.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4-6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al, 5,633,042 (Nakamura) in view of Hoefer et al, US 2004/0087684 A1 (Hoefer '684) for reasons of record.

Claims 6, 8, 10, and 12 are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113.

Nakamura teaches method of coating a glass substrate comprising providing a glass substrate, applying to the glass substrate a coating composition comprising a solventless bisphenolic epoxy and a hardener and curing the coating composition. See Examples. Nakamura does not specifically teach that the epoxy is the reaction product of epichlorohydrin and either bisphenol A or bisphenol F, or that the hardener is water-dilutable or that his composition contains water.

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Hoefer '684 teaches coating compositions comprising an epoxy resin that is a reaction product of epichlorohydrin and a component selected from bisphenol A and bisphenol F, a water-dilutable epoxy resin hardener and water. See abstracts. Hoefer '684 does not specifically teach a method of coating a glass substrate with said coating composition.

While Nakamura does not specifically teach that his epoxy is the reaction product of epichlorohydrin and either bisphenol A or bisphenol F, the fact that he teaches a bisphenolic epoxy would have provided a suggestion to the skilled artisan for the type of epoxy resin contemplated by applicants. Moreover, there is no clear showing on this record of criticality that is directly related to the instant epoxy resin. Accordingly, the compositions of Nakamura and Hoefer '684 are sufficiently close that one of ordinary skill in the art would immediately envisage substituting the compositions taught by Nakamura with one of those taught by Hoefer '684. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method of coating a glass substrate as taught by Nakamura by using the compositions taught by Hoefer '684 with the reasonable expectation of success.

Claim Rejections - 35 USC § 102

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 6, 8, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al, 5,633,042 (Nakamura).

As set forth above, claims 6, 8, 10, and 12 are product-by-process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113.

Accordingly, the examiner has interpreted these claims to embrace the end product of a glass fiber coated with a cured epoxy resin.

Nakamura, as set forth above, teaches glass fiber substrates coated with a composition comprising bisphenolic epoxy resin and a hardener and curing said coated substrate to result in the end product of a glass fiber cloth coated with a cured epoxy resin. Hence, the teachings of Nakamura anticipate the invention as claimed in product-by-process claims 6, 8, 10 and 12. There is no evidence on this record of a patentably distinct end product from the prior art products.

Response to Arguments

5. Applicant's arguments filed February 22, 2007 have been fully considered but they are not persuasive.

Applicants argue that Nakamura is deficient in that he neither teaches nor suggest a composition containing a water-dilutable epoxy resin hardener and water and he does not teach or suggest utilizing an epoxy resin, which is liquid at 20°C in admixture with water and water-dilutable epoxy resin hardener.

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The examiner disagrees. In particular, Nakamura discloses at column 26, lines 45-68 that his epoxy resin contains 50 weight % or more of epoxy resin in liquid state at 25° C, further teaching that the epoxy in liquid state may be bisphenol A type epoxy or bisphenol F type epoxy resin. This disclosure would render obvious epoxy that is liquid at 20°C.

Applicants argue that in the present claims, the thermosetting resin composition containing no solvent in a molten state is utilized in impregnating the glass cloth substrate.

In this regard, it should be noted that present claim 1 is not so limited. While the epoxy reaction product is solventless, the coating composition contain up to 98% water, which is a solvent.

Applicants argue the process of Nakamura is complex and requires precise temperature controls.

In this concern, it is the position of the examiner that Nakamura teaches the instant claimed process steps of providing a glass substrate, applying a coating composition to said substrate and curing said coating composition. Also, claim 1 does not exclude additional process steps.

Applicants argue that Hoefer '684 in combination with Nakamura is not related to the present invention and that although Hoefer '684 utilizes a composition similar to the composition useful for coating glass disclosed in the present application, it does not disclose or suggest being useful for coating glass.

In this regard, the fact that Hoefer '684 may not disclose his composition coated on glass cloth substrates does not preclude his clear disclosure that his composition is a coating composition that can be coated on various substrates. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). The combined teachings of Nakamura and Hoefer '684 would have provided a suggestion to one having ordinary skill in this art that the coating composition of Hoefer '684 could be applied to glass substrates.

Applicants argue that the products of claims 6, 8, 10 and 12 are different from the cured polymer disclosed in Nakamura and therefore are not taught or suggested by the references.

In this concern, end product of a coated glass fiber appears to be the same as that disclosed by the prior art. There is no clear evidence on this record to the contrary.

No claims are allowed.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

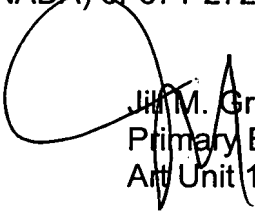
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jill M. Gray
Primary Examiner
Art Unit 1774

jmg